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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/814,066 | 06/21/2001 | Franz Knauseder | P26741 | 2541 |

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| EXAMINER | |
|---|---|
| SAFAVI, MICHAEL | |
| ART UNIT | PAPER NUMBER |
| 3637 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 07/28/2008 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
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| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/814,066 | KNAUSEDER, FRANZ | |
| | Examiner | Art Unit | |
| | Michael Safavi | 3637 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *02 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-24 and 26-36* is/are pending in the application.

4a) Of the above claim(s) *4-20 and 26-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,21-24 and 31-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/24/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

### *Drawings*

The drawings filed on March 22, 2001 are subject to correction of the informalities indicated on the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1-3, 21-24, and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962).**

Kaindl '560 discloses the configuration of attaching flat structural cladding or substrate components as recited in claims 1-20 of the instant application. Kaindl '560 does not appear to disclose any specific use of adhesive with the attaching configuration. However, Witex Co. '962 teaches utilization of a pre-applied contact adhesive between tongue and groove joints so as to establish a secure engagement between cladding panels of a substrate. Witex Co. '962 discloses a "contact glue" as well as a glue activated by heat with both disclosed as pre-applied at the factory, (see

translation of Witex Co. '962 as at page 4, line 19 to page 5, line 4; page 5, line 20 to page 6, line 6; page 7, lines 6-11; and page 8, lines 2-5 and 10-13).

Therefore, to have provided the floor tile assembly of Kaindl '560 with adhesive, including a pre-applied adhesive, between and within the tongue and groove joints connecting the panels 1, 2, thus securely fastening adjacent floor tiles one to another while realizing any and all advantages of adhesives within a self-locking joint, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by Witex Co. '962. The recitations to "a pre-applied adhesive layer" as well as "applied off site" have not been afforded patentable weight as being directed to process in a claim to article of manufacture. However, Witex Co. '962 obviously teaches application of the adhesive "prior to connection" at "another site", (i.e., teaches "a pre-applied adhesive layer" as well as "applied off site").

As concerns **claim 3,** the resulting panels would have at least one of the lateral groove areas of the grooves provided with the adhesive and at least one of the sides of the tongue provided with the adhesive, (i.e., "the grooves of the individual panels are provided with the pre-applied adhesive layer, or the pre-applied layer of a substance which activates an adhesive having the form of a filling, a coating, a covering, or a strand, and the tongues are provided with the pre-applied adhesive layer, or the pre-applied layer of a substance which activates an adhesive having the form of a coating, a surface impregnation, a covering, or a strand"), page 9, lines 5-7 of the translation of Witex Co. '962.

As concerns **claims 32, 33, and 35**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as is taught by Witex Co. '962 on page 4, lines 1-6 and page 5, lines 7-9.

**Claims 1-3, 21-24, and 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962), as applied to claims 1-3, 21-25, and 31-35 above, and further in view of Roesch et al.**

Though the limitation presented within each of claims 1, 31, and 34 to "pre-applied adhesive layer" is deemed met by the above rejection of claims , Roesch et al., for example, teach utilization and advantages of various "two component" adhesives including microencapsulatable solvent adhesives that contain polymer resin and appropriate solvents as well as polyvinyl acetate base, methyl acrylate base, epoxide base etc. with such adhesives falling into a category of "latent adhesive material that becomes active after appropriate activation" along with "an activator which induces adhesion". Roesch et al. teaches application to either one or both members being connected, col. 10, line 9. Roesch et al. further teaches application to either one or both members "prior to connection" at "another site", (i.e., teaches "a pre-applied adhesive layer" as well as "applied off site"), col. 10, lines 36-40 and col. 5, lines 54-58.

Therefore, to have provided the modified floor tile assembly of Kaindl '560 with a pre-applied two component adhesive, (including adhesive with activating substance, microencapsulated adhesive, etc.), between and within the tongue and groove joints connecting the panels 1, 2, thus securely fastening adjacent floor tiles one to another while realizing any and all advantages of such well known adhesives and particularly "two component adhesives", would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by Roesch et al. The recitations to "a pre-applied adhesive layer" as well as "applied off site" have not been afforded patentable weight as being directed to process in a claim to article of manufacture. However, Roesch et al. obviously teaches application of the adhesive "prior to connection" at "another site", (i.e., teaches "a pre-applied adhesive layer" as well as "applied off site").

As concerns **claim 3,** the resulting panels would have at least one of the lateral groove areas of the grooves provided with the adhesive and at least one of the sides of the tongue provided with the adhesive, (i.e., "the grooves of the individual panels are provided with the pre-applied adhesive layer, or the pre-applied layer of a substance which activates an adhesive having the form of a filling, a coating, a covering, or a strand, and the tongues are provided with the pre-applied adhesive layer, or the pre-applied layer of a substance which activates an adhesive having the form of a coating, a surface impregnation, a covering, or a strand"), page 9, lines 5-7 of the translation of Witex Co. '962.

As concerns **claims 32, 33, and 35**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as is taught by Witex Co. '962 on page 4, lines 1-6 and page 5, lines 7-9.

As concerns **claim 36**, the resulting panels would have at least one component of a two-component glue along a first, (or tongue), edge and at least another component of the two-component glue along a second, (or groove), edge.

**Claims 32, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962), as applied to claims 1-3, 21-25, and 31-35 above, and further in view of any of Robins et al. '902, Sjostedt et al. '715, Parasin '816, and Ryther '892.**

Though the limitation presented within each of claims 32, 33, and 35 appear as a presumed or desired effect which one of ordinary skill in the art would have obviously desired, each of Robuns et al., Sjostedt et al., Parasin, and Ryther recognize the undesirability of excess adhesive seepage and therefore teach to abate as much as possible any undesirable effects of any possible excess adhesive seepage, col. 4, lines 11-13 of Robins et al.; col. 9, line 65 to col. 10, line 10 of Sjostedt et al.; col. 3, lines 18-20 and claim 4 of Parasin; and col. 1, lines 63-67, col. 2, lines 32-36, col. 3, lines 18-20,

and col. 4, lines 33-35 of Ryther. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the modified Kaindl '560 assembly with adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as taught by any of Robins et al., Sjostedt et al., Parasin, and Ryther.

**Claims 32, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962), when considering Roesch et al. as applied to claims 1-3, 21-25, and 31-36 above, and further in view of any of Robins et al. '902, Sjostedt et al. '715, Parasin '816, and Ryther '892.**

Though the limitation presented within each of claims 32, 33, and 35 appear as a presumed or desired effect which one of ordinary skill in the art would have obviously desired, each of Robins et al., Sjostedt et al., Parasin, and Ryther recognize the undesirability of excess adhesive seepage and therefore teach to abate as much as possible any undesirable effects of any possible excess adhesive seepage, col. 4, lines 11-13 of Robins et al.; col. 9, line 65 to col. 10, line 10 of Sjostedt et al.; col. 3, lines 18-20 and claim 4 of Parasin; and col. 1, lines 63-67, col. 2, lines 32-36, col. 3, lines 18-20, and col. 4, lines 33-35 of Ryther. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the modified Kaindl '560 assembly with adhesive in any quantity including an amount that would not

allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as taught by any of Robins et al., Sjostedt et al., Parasin, and Ryther.

### *Response to Arguments*

Applicant's arguments filed April 02, 2008 have been fully considered but they are not persuasive. Reference is made to the examiner's arguments presented within the Examiner's answer of November 21, 2006 and the supplemental Examiner's answer of July 11, 2007 as well as the examiner's remarks within the advisory action of December 13, 2005 and the final Office action of September 22, 2005.

In any event, with particular regard to Applicant's arguments against each of Robins et al., Sjostedt et al., Parasin, and Ryther, the limitation presented within each of claims 32, 33, and 35 appear as a presumed or desired effect which one of ordinary skill in the art would have obviously desired. Each of Robins et al., Sjostedt et al., Parasin, and Ryther recognize the undesirability of excess adhesive seepage and therefore teach to abate as much as possible any undesirable effects of any possible excess adhesive seepage. The language of claims 32, 33, and 35 does not present any limitation that is not disclosed, suggested or taught by any of Robins et al., Sjostedt et al., Parasin, and Ryther, (i.e., "the pre-applied adhesive layer or the pre-applied layer of a substance which activates an adhesive is applied in an amount which is insufficient to cause any excess to well out onto a decorative surface of the flat structural panels when the flat structural panels are joined together").

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Safavi whose telephone number is (571) 272-7046. The examiner can normally be reached on Mon.-Fri., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Michael Safavi/
Primary Examiner, Art Unit 3637

M. Safavi
July 12, 2008